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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,659	03/29/2000	Krishna Murthy	199-1255	5957

7590 05/24/2004

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EXAMINER

GARCIA OTERO, EDUARDO

ART UNIT	PAPER NUMBER
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2123

19

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n N .

09/537,659

Applicant(s)

MURTHY ET AL.

Examiner

Eduardo Garcia-Otero

Art Unit

2123

--Th MAILING DATE of this communication appears n the cover sheet with the correspondence address --

THE REPLY FILED 23 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-16.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 18.
10. ☐ Other: _____

Regarding 09/537,659.

PROPOSED AMENDMENT. The proposed amendment to claim 2 will not be entered because it introduces an additional limitation or element, specifically "an additional information database". Second, said additional information database creates indefiniteness issues regarding the term "the information base", because it is not clear which information database is referred to (the first, or the additional).

Thus, the proposed amendment is not entered.

35 USC 112 FIRST PARAGRAPH

REQUIREMENT. Applicant Remarks page 9 persuasively asserts that the term "requirement" is adequately described at specification page 14 line 13 through page 15 line 2.

LIBRARY. Applicant Remarks page 10 unpersuasively asserts that the term "a knowledge based engineering library" is adequately described and enabled by specification page 6 lines 3-20, in view of US Patents 6,113,644 and 6,487,525. Note that the specification page 6 states "information such as design, assembly and manufacturing rules and guidelines". However, the libraries in said patents do not appear to contain such knowledge based expert system information, but rather appear to be ordinary parts libraries without such rules and guidelines.

CORRELATES. Applicant Remarks page 11 unpersuasively asserts that the term "correlates" is adequately described and enabled. Said "correlates" appears to be a very high level expert system function, and is not adequately described and enabled. Please note the discussion of expert system in the prior office action, particularly paragraph 31 stating that it took 14 man-months to document 150 rules for making sterile soup.

Additionally, note the legal precedent in paragraph 32 of the prior action, in which 1-12 to 2 manyears was held to be a "clearly unreasonable" amount of experimentation and development.

Note that the present application does not explicitly state any such rules or guidelines.

Thus, the 35 USC 112 first paragraph rejections are withdrawn only with respect to the term "requirement", but maintained with respect to all other terms. Thus all claims are still rejected under 35 USC first paragraph.

35 USC 112 SECOND PARAGRAPH

Similar to the above discussion, the 35 USC 112 second paragraph rejections are withdrawn only with respect to the term "requirement", but maintained with respect to all other terms.

35 USC 103 REJECTIONS.

Applicant unpersuasively asserts that Juran and Tucker do not disclose all of the claimed limitations. Juran and Tucker must be interpreted in the view of one of ordinary skill in the art at the time of the invention. The instant application was filed 3/29/2000, and no earlier priority date is claimed.

For example, one of ordinary skill in the art would interpret Tucker's discussion of "Internet" as disclosing the Claim 1 term "information portal on the computer system".

Note that "portal" is defined by The Authoritative Dictionary of IEEE Standards and Terms, Seventh Edition, by IEEE Press, ISBN 0-7381-2601-2, 2000, as "The logical point at which medium access control (MAC) service data units (MSDUs) from a non-IEEE 802.11 local area network (LAN) enter the distribution system (DS) of an extended service set (ESS)". In other words, an information portal (on a computer system) is the standard way to access the Internet.

Thus, all 35 USC 103 rejections are maintained.



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